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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/821,477
Filing Date: April 08, 2004
Appellant(s): HASEGAWA, YUKA

Max Moskowitz
For Appellant

EXAMINER'S ANSWER (Supplemental)

This is in response to the appeal brief filed 8-25-2006 appealing from the Office action mailed 2-1-2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct (submitted by the applicant in response to non-compliant appeal brief).

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,515,695	Sato et al.	2-4-2003
JP07-115633	Nishimura	5-2-1995
JP11-234641	Saiki et al.	8-27-1999

JP2003-032727

Nakajima

1-31-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (US PAT: 6,515,695, filed 11-8-1999, hereinafter Sato) in view of Nishimura (JP07-115633).

Regarding claims 1 and 13, Sato discloses a videophone terminal for conducting a call with a communicating terminal by communicating voice and sound and an image, comprising: imaging means (15, fig. 1) for shooting an image, a microphone (21, fig. 1) for converting voice and sound into an electric signal, display means (14, fig. 1), for displaying a screen image, a communicating means (17, fig. 1) for communicating a call, a storage means (11, fig. 1) for beforehand storing telephone book table including a telephone number and a reply method with a relationship established there between, and a control means (10, fig. 1) for conducting control at reception of a call from a communicating terminal to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating

terminal in the telephone book table stored in the storage means (col. 7, line 30 – col. 8, line 34; col. 10, line 1 – col. 11, line 26; col. 14, line 14 – col. 15, line 21; col. 16, line 50 – col. 17, line 47; figs.

1, 2, 4).

Sato differs from claims 1 and 13 in that he does not teach the following: the reply method including using any one of a camera image, a still image, or a substitute image.

However, Nishimura discloses video telephone system which teaches the following: the reply method including a still image (abstract; paragraphs: 0006, 0010-0016).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Sato's system to provide for the following: the reply method including using any one of a camera image, a still image, or a substitute image as this arrangement would facilitate audio and video message appropriate for the caller as taught by Nishimura, thus facilitating sending appropriate message to the caller suitable for him.

Sato differs from claims 2,14 in that he does not teach the following: telephone book table relates a telephone number of a communicating terminal to a reply method to send a reply as an answering telephone, the control means makes at reception of a call, when an answering reply mode to send a replay as an answering telephone is set in advance, a search through telephone book table and transmits, when the telephone number of the communicating party is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to reply method,

However, Nishimura discloses video telephone system which teaches the following: telephone book table relates a telephone number of a communicating terminal to a reply method to send a reply as an answering telephone, the control means makes at reception of a call, when an answering reply mode to send a reply as an answering telephone is set in advance, a search through telephone book table and transmits, when the telephone number of the communicating party is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to reply method (Drawings: 1-8, paragraphs: 0006 – 0011 and see effect of the invention).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Sato's system to provide for the following: telephone book table relates a telephone number of a communicating terminal to a reply method to send a reply as an answering telephone, the control means makes at reception of a call, when an answering reply mode to send a reply as an answering telephone is set in advance, a search through telephone book table and transmits, when the telephone number of the communicating party is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to reply method as this arrangement would provide means for sending a reply message that best matches the telephone number of the calling party as taught by Nishimura.

3. Claims 8-9, 20-21, are rejected under 35 U.S.C 102(b) as being anticipated by Nishimura (JP07-115633).

Regarding claim 8, Nishimura discloses a screen display setting method for use with a videophone terminal for conducting a call with a communicating terminal by communicating voice and sound and an image including imaging means for shooting a image, a microphone for

converting voice and sound into an electric signal, display means for displaying a screen image, and a communicating means for communicating a call, the method comprising: a reply setting step of relating in a telephone book table a telephone number of a communicating terminal to a reply method at reception of a call according to an input from an input means, and a reply step of conducting control at a reception of a call from a communicating terminal to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table (Drawings: 1-8, paragraphs: 0006 – 0016), the reply method including a reply using one of a camera image, still image or substitute image (abstract; paragraphs: 10-16).

Regarding claim 20, Nishimura discloses a screen display setting method for use with a videophone terminal for conducting a call with a communicating terminal by communicating voice and sound and an image including imaging means for shooting a image, a microphone for converting voice and sound into an electric signal, display means for displaying a screen image, and a communicating means for communicating a call, the method comprising: a reply setting step of relating, according to an input from an input means of one videophone terminal selected from the videophone terminals, a telephone number of a communicating terminal to a reply method at reception of a call in a telephone book table by the videophone terminal selected from the videophone terminals, and a reply step of conducting control by the videophone terminal at reception of a call from a communicating terminal to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table

(Drawings: 1-8, paragraphs: 0006 – 0016), the reply method including a reply using one of a camera image, still image or substitute image (abstract; paragraphs: 10-16).

Regarding claims 9 and 21, Nishimura further teaches the following: the telephone book table (Drawing: 3) relates a telephone number of a communicating terminal to a reply method of sending a reply as an answering telephone, and the control means, at reception of a call in a state in which the videophone terminal is set to reply as an answering telephone in advance, a search through the telephone book table and transmits, when the telephone number of the communicating terminal of the call is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to the reply method, an answering reply setting step of relating, according to an input means of one videophone terminal selected from the videophone terminals, in a telephone book table a telephone number of a communicating terminal to a reply method to send a reply as an answering telephone to the communicating terminal by the videophone terminal selected from the videophone terminals, and an answering reply step of conducting by the videophone terminal control at reception of a call from a communicating terminal in a state in which the videophone terminal is beforehand set to reply as an answering telephone, to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method as an answering telephone related to a telephone number of the communicating terminal in the telephone book table (Drawings: 1-8, paragraphs: 0006 – 0016).

4. Claims 3-7 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Nishimura as applied to claims 1 and 13 above, and further in view of Saiki et al. (JP11-234641, hereinafter Saiki).

The combination differs from claims 3-4, 7 and 15-19 in that it does not teach the following: the reply method includes a reply using a substitute image expressing a feature of a movement in an image shot by the imaging device by movement of a character beforehand set, and the control means includes a substitute image display control section for converting the image shot by the imaging means into the substitute image, the reply using the substitute image includes a reply using voice and sound, the substitute image display control section converts voice and sound from microphone into voice and sound corresponding to substitute image, the replay method includes a reply using a camera image shot by the imaging means and reply using a still picture, the control means includes camera image display control means for displaying the camera image shot by the imaging means, and a still picture display control means for displaying a still image using an image stored in the storage means.

However, Saiki discloses display device for image of video telephone set which teaches the following: the reply method includes a reply using a substitute image expressing a feature of a movement in an image shot by the imaging device by movement of a character beforehand set, and the control means includes a substitute image display control section for converting the image shot by the imaging means into the substitute image, the reply using the substitute image includes a reply using voice and sound, the substitute image display control section converts voice and sound from microphone into voice and sound corresponding to substitute image, the replay method includes a reply using a camera image shot by the imaging means and reply using a still picture, the control means includes camera image display control means for displaying the camera image shot by the imaging means, and a still picture display control means for displaying

a still image using an image stored in the storage means (Drawing 1, paragraphs: 0010 –0038 and 0057).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: the reply method includes a reply using a substitute image expressing a feature of a movement in an image shot by the imaging device by movement of a character beforehand set, and the control means includes a substitute image display control section for converting the image shot by the imaging means into the substitute image, the reply using the substitute image includes a reply using voice and sound, the substitute image display control section converts voice and sound from microphone into voice and sound corresponding to substitute image, the replay method includes a reply using a camera image shot by the imaging means and reply using a still picture, the control means includes camera image display control means for displaying the camera image shot by the imaging means, and a still picture display control means for displaying a still image using an image stored in the storage means as this arrangement would facilitate to communicate with communication partners while keeping the privacy of the communication partners as taught by Saiki, thus providing a communication arrangement to suite the needs of the users.

Regarding claim 5, the combination teaches the following: the communicating means includes a function to establish a connection to a network, data is obtained for the character via the network from the communicating means and is stored in the storage means (col. 11 lines 20-67 of '695).

5. Claims 10-11, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura in view of Saiki.

Nishimura differs from claims 11-12 and 22-23 in that he does not teach the following: reply method includes a reply using a substitute image expressing a feature of the movement in image shot by the imaging device by movement of a character beforehand set, reply using the substitute image includes a reply using voice and sound corresponding to the substitute image.

Saiki teaches the following: reply method includes a reply using a substitute image expressing a feature of the movement in image shot by the imaging device by movement of a character beforehand set, reply using the substitute image includes a reply using voice and sound corresponding to the substitute image (Drawing 1, paragraphs: 0010 –0038 and 0057).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishimura to provide for the following: reply method includes a reply using a substitute image expressing a feature of the movement in image shot by the imaging device by movement of a character beforehand set, reply using the substitute image includes a reply using voice and sound corresponding to the substitute image as this arrangement would facilitate to communicate with communication partners while keeping the privacy of the communication partners as taught by Saiki, thus providing a communication arrangement to suite the needs of the users.

6. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura in view of Nakajima (JP2003032727A).

Nishimura differs from claims 12 and 24, he does not teach the following: communication means includes a function to establish connection to a network, the method further

comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means.

However, Nakajima teaches the following: communication means includes a function to establish connection to a network, the method further comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means (Drawing 1; see abstract, and paragraphs: 0007-0008; and effect of invention).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishimura to provide for the following: communication means includes a function to establish connection to a network, the method further comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means as this arrangement would provide means to obtain required data from an external source as taught by Nakajima, thus facilitating the user to use the data for further processing.

(10) Response to Argument

A. Rejection under 35 U.S.C 103(a) over Sato et al. in view of Nishimura of claims 1-

2 and 13-14:

Regarding rejection of independent claims 1 and 13 using the above combination of references, Appellant argues that “The Examiner contends that Sato et al. discloses “control means ... for conducting control at a reception of call from a communicating terminal to

convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table stored in the storage means". Appellant further alleges that "none of the cited portions of Sato et al. discloses, teach, or suggest either conducting control at reception of a call ie a reply method related to a telephone number of the communication terminal. On the contrary, all of the cited portions of Sato et al. and indeed also od Sato et al. focuses on multimedia communication terminal ... and there is no disclosure, teaching or suggestion of the procedures for conducting control at reception of a call or replay methods at reception of a call, as required in independent claims 1 and 13". Contrary to appellant's interpretation of Sato et al. reference, Sato et al. teaches the following: the phone book memory (11, fig. 1) is used to store phone numbers of other terminals and information associated therewith, which includes a flag indicating whether information of the present user is sent or not, and a flag indicating whether transmission/reception of video data is permitted or not (col. 8 lines 5-35; col. 17 lines 26-32), and which is equivalent to the reply method at reception of a call defined in the claims 1 and 13.

Appellant further argues, "The Examiner admits that Sato et al. does not teach the feature of the reply method including any one of camera image, still image, or a substitute image, found in independent claims 1 and 13, but contends that Nishimura discloses a "video telephone system which teaches the following: the reply method including a still image (abstract; paragraphs: 0006, 0010-0016)". In Advisory Action mailed in May 23, 2005, the Examiner inconsistently contends that "Nishimura discloses a video telephone in which reply method including [sic] a

reply using any one of camera image, or still image, “ (page 3, lines 5-7)”. Regarding this, Examiner interprets the term “any one of” to mean in alternate form one of still image, camera image or substitute image. Nishimura discloses storing plural response messages in a voice message storage part and a video message storage part and registering which response message is transmitted to which party in a message selection registrations part (abstract; 0006, 0010-0016). Therefore, Nishimura clearly teaches sending a response message that involves stored video and audio which clearly reads on applicant’s claim limitation, viz: a reply using any one of camera image, or still image. Appellant further launches into nuances of the meaning of the phrase “any one of” and asserts that phrase “any one of” should be interpreted to require the reply method include using a camera image, a reply using a still image, and reply using a substitute image. As explained above, Examiner respectfully submits that phrase “any one of” is open to interpretation in alternate form to mean one of still image, camera image or substitute image and as long as the reference teaches use of still image or camera image, it is sufficient to meet the claim limitation. In this context, Examiner respectfully submits that Nishimura clearly reads on the Appellant’s claim limitation: a reply using any one of camera image, or still image or substitute image.

Appellant further alleges “there is no motivation for one of ordinary skill in the art to combine Nishimura with Sato et al. since, as previously stated, Sato et al. only teaches, discloses, and suggests a process of using a multimedia communication terminal to make outgoing calls, whereas Nishimura discloses the use of video telephone in response to incoming calls”. Regarding this, as already elaborated earlier, Sato et al. contrary to appellant’s interpretation of Sato et al. reference, Sato et al. teaches the following: the phone book memory (11, fig. 1) is used to store phone numbers of other terminals and information

associated therewith, which includes a flag indicating whether information of the present user is sent or not, and a flag indicating whether transmission/reception of video data is permitted or not (col. 8 lines 5-35; col. 17 lines 26-32), and which is equivalent to the reply method at reception of a call defined in the claims 1 and 13. Further, Nishimura teaches reply method using any one of still image, camera image and audio customized for each caller (abstract). Therefore one of ordinary skill in the art at the time invention was made would be motivated to use the teachings of Nishimura in Sato et al. to provide for customized audio and video replay transmission appropriate for each caller as taught by Nishimura.

Appellant arguments regarding dependent claims 2 and 14 are tied to independent claims 1 and 13 being allowable which are not as explained above.

B. Rejection under 35 U.S.C 102(b) over Nishimura of Claims 8-9 and 20-21

Regarding rejection of these claims, Appellant argues that “Independent claim 8 provides for, “a reply step of conducting control at reception of a call from a communicating terminal to convert an image and voice to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table, the reply method including a replay using any one of a camera image, a still image, or a substitute image”. Appellant further argues that “Independent claim 20 provides for, “reply step of conducting control by the videophone terminal at reception of a call from a communicating terminal to convert an image and voice and sound from the videophone terminal to a communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table including a reply using any one of a camera image, still image, or a substitute image”. Appellant

then alleges that “As stated previously, however, Nishimura only discloses the use of images in replies and does not specify use of any one of camera image, a still image, or a substitute image in a replay, as required by the independent claims 8 and 20” Regarding this, Nishimura clearly teaches reply method involving camera image or still image corresponding to telephone number in a phone book entry (Drawings: 1-8; abstract; paragraphs: 0006-0016). Appellant argument regarding reply method involving any one of camera image, still image, or substitute image is already addressed in response to Appellant’s arguments regarding Nishimura reference with respect to independent claims 1 and 13 and Examiner respectfully urges the BPAI to refer to that explanation under item A.

Appellant arguments on dependent claims 9 and 21 are tied to independent claims 8 and 20 being allowable which are not as explained above.

C. Rejection under 35 U.S.C 103(a) over Sato et al. in view of Nishimura and further in view of Saiki et al. JP11-234641, of claims 3-7 and 15-19:

Regarding rejection of claims 3-7 and 15-19, Appellant’s first set of arguments are tied to their independent claims 1 and 13 being allowable which are not as set forth above. Appellant’s second set of arguments are addressed to Saiki et al. and argues that “Specifically, although Saiki et al. discloses an image storage, which memorizes image data from image decoding equipment or image data transmission, (page 2 of English translation of Saiki et al. provided by the examiner, lines 4-5), there is no disclosure, teaching, or suggestion of a “substitute image expressing a feature movement in an image by imaging means” by “a movement of a character beforehand set,” as claimed in claims 2-3 and 15, and, thus, in claims 4-7 and 16-19, to the extent that claims 4-7 and 16-19 are directly or indirectly dependent upon claims 3 and 15,

respectively”. Regarding this, contrary to Appellant’s interpretation of Saiki et al reference, Saiki et al. clearly teaches transmitting image data selected from image stored, and also from external image input such as Television, VTR, etc (paragraphs: 0027-0028; 0032; 0057; abstract). This clearly reads on appellant’s claim limitation such as “substitute image expressing a feature movement in an image by imaging means” by “a movement of a character beforehand set,” as claimed in claims 2-3 and 15, and, thus, in claims 4-7 and 16-19.

Appellant further alleges that “To the extent that claim 6 is directly or indirectly dependent upon independent claim 1, and claim 18 is directly or indirectly dependent upon independent claim 13, Saiki et al., although it discusses sending image data selected manually or automatically to another party, no where teaches, discloses, or suggests a reply method including using any one of camera image, a still image, or substitute image, as required by claims 1 and 13”. Regarding this, as explained above in response to Appellant’s arguments with respect to independent claims 1 and 13, Nishimura teaches reply method involving any one of camera image, still image (abstract), in which phrase any one of is interpreted in alternate form to mean one of camera image, still image etc. Further, Saiki et al. also teaches transmitting image data selected from image stored, and also from external image input such as Television, VTR, etc (paragraphs: 0027-0028; 0032; 0057; abstract) which also reads on Appellant’s claim limitation such as reply method including using any one of camera image, a still image, or substitute image, as required by claims 1 and 13.

C. Rejection under 35 U.S.C 103(a) over Nishimura in view of Saiki et al. of Claims 10-11 and 22-23

Regarding rejection these claims Appellant's first set of arguments are tied to their independent claims 8 and 20 being allowable which are not as set forth above. Appellant's second set of arguments are addressed to Saiki et al. and argues that "With regard to Saiki et al., both claims 10 and 12, and, therefore, also claims 11 and 23, dependent upon claims 10 and 22, respectively, requires that a substitute image expresses "a feature of a movement in an image shot by the imaging means by movement of a character beforehand set," analogously to claims 3 and 15, and therefore, claims 10-11 and 22-23 are allowable over Saiki et al for the same reasons recited above with respect to claims 3 and 15. Regarding this, contrary to Appellant's interpretation of Saiki et al reference, Saiki et al. clearly teaches transmitting image data selected from image stored, and also from external image input such as Television, VTR, etc (paragraphs: 0027-0028; 0032; 0057; abstract). This clearly reads on appellant's claim limitation such as a feature of a movement in an image shot by the imaging means by movement of a character beforehand set," analogously to claims 3 and 15, and therefore, claims 10-11 and 22-23. Since, the combination of Nishimura and Saiki et al. teaches limitations of claims 10-11 and 22-233, the claims are not allowable.

D. Rejection under 35 U.S.C 103(a) over Nishimura in view of Nakajima
JP2003032727A of Claims 12 and 24

Regarding rejection of claims 12 and 24, Appellants arguments are tied to independent claims 8 and 20 being allowable which are not as explained above.

Regarding Nakajima reference appellant argues that "it relates to the downloading and display of image data on an image display means, (abstract) and does not teach, disclose, or

suggest control at reception of a call from a communicating terminal to a reply method related to telephone number of a communicating terminal, the reply method including a reply using any one of a camera image, still image, or a substitute image, as required in independent claims 8 and 20, and therefore, in dependent claims 12 and 24". Regarding this, Nakajima reference is used to reject limitations such as communication means includes a function to establish connection to a network, the method further comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means which he teaches (see abstract, and paragraphs: 0007-0008; and effect of invention). As for the other limitations such as control at reception of a call from a communicating terminal to a reply method related to telephone number of a communicating terminal, the reply method including a reply using any one of a camera image, still image, or a substitute image, as required in independent claims 8 and 20, these limitations are taught by Nishimura as explained above in responding to appellant's arguments regarding independent claims 8 and 20 under item B above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

Application/Control Number: 10/821,477
Art Unit: 2614

Page 20

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